

Applicant: P. Bonutti
Application No.: 10/755,996
Examiner: D. Reip

Remarks

Claims 1, 4-10, 13-15, and 19-23 are pending in the application and are presented for the Examiner's review and consideration. Claims 1, 14, and 20 have been amended. Claim 23 has been added. Claims 2, 3, 11, 12, and 16-18 are canceled. Applicant believes the claim amendments and accompanying remarks herein serve to clarify the present invention and are independent of patentability. No new matter has been added.

35 U.S.C. §103 Rejections

Claims 1, 8, 9, and 13-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,609,635 to Michelson ("Michelson") in view of U.S. Patent No. 5,514,180 to Heggeness *et al.* ("Heggeness"). Claims 4-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Michelson in view of Heggeness, and further in view of U.S. Patent No. 4,394,370 to Jefferies ("Jefferies"). Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Michelson in view of Heggeness, and further in view of U.S. Patent No. 5,669,909 to Zdeblick *et al.* ("Zdeblick"). In response, Applicant respectfully submits that these rejections should be withdrawn.

Applicant discloses, *inter alia*, that the wedge member 44 (FIGS. 5-7) tapers from a thick end portion 50 to a thin end portion 52. The wedge member 44 has flat upper and lower major side surfaces 54 and 56 (FIG. 7) which slope toward each other from the thick end portion 50 to the thin end portion 52. The major side surfaces 54 and 56 intersect at the thin end portion 52. The pointed thin end portion 52 of the wedge member 44 facilitates moving the wedge member into the joint 34 between the bones 30 and 32 (FIG. 2). (¶0049).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). (see also MPEP §2143.03). Applicant contends that Michelson, Heggeness, Jefferies, and Zdeblick fail to teach or suggest the claimed invention. For example, independent claim 1 recites, *inter alia*, an implantable device comprising a body including one bone-contacting surface which

Applicant: P. Bonutti
Application No.: 10/755,996
Examiner: D. Reip

tapers to form a pointed edge with another bone-contacting surface. Applicant contends that the cited references, alone or in any combination, fail to teach or suggest Applicant's device which tapers to a pointed edge.

Based on the foregoing, Applicant respectfully submits that amended claim 1 is patentable over Michelson, Heggeness, Jefferies, and Zdeblick. Based on at least their dependencies, Applicant submits that claims 4-10, 13-15, and 19-23 are patentable as well.

Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

A fee of \$395 is believed to be due for a Request for Continued Examination. A PTO-2038 Credit Card Payment Form is submitted herewith. Please charge any additional fees (or credit any overpayment of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 780-A02-021-5).

Respectfully submitted,



Paul D. Bianco, Reg. # 43,500

Customer Number: 33771

Paul D. Bianco

FLET KAIN GIBBONS GUTMAN BONGINI & BIANCO

21355 East Dixie Highway, Suite 115

Miami, Florida 33120

Tel: 305-830-2600; Fax: 305-830-2605

e-mail: pbianco@focusonip.com